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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re patent application of: |) | Before the Examiner |
| SCHIPPER, Hyman, et al. |) | Randall O. Winston |
| Serial No. 09/776,913 |) | |
| Filed: February 6, 2001 |) | Group Art Unit: 1652 |
| HO-1 AS A DIAGNOSTIC AND PROGNOSTIC |) | |
| TEST FOR DEMENTING DISEASES |) | |

RESPONSE

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

This letter is filed in response to the Office Action dated January 28, 2003.

REMARKS

The Examiner has rejected claims 1 through 8 pursuant to 35 USC § 102(b) as being anticipated by Schipper, *et al.* (1997) Blood Heme Oxygenase-1 Levels are Decreased in Alzheimer Disease, Soc. Neuroscience 23:1641. In response, the Applicant respectfully submits that this particular abstract was published at the 1997 Society for Neuroscience Annual Meeting in New Orleans. This conference was held between October 25 and 30th, 1997. The present application claims benefit under 35 USC § 119(e) from a provisional United States patent application (Serial Number 60/098,141) filed August 27, 1998. Since the effective U.S. filing date of this application is August 27, 1998, the Schipper, *et al.* (1997) is not citable under 35 USC § 102(b). Although one of the authors of the Schipper, *et al.* abstract (H. Bergman) is not named as an inventor in the instant application, he did not make an inventive contribution to the subject matter disclosed in this application. As mentioned in the declaration pursuant to 37 CFR 1.131 filed during the prosecution of the parent application Serial Number 09/323,248 (now U.S. Patent 6,210,895), H. Bergman's role was

limited to providing access to blood samples to the inventors. Therefore, in light of the above, the Examiner is respectfully requested to reconsider this rejection.

The Examiner has rejected claims 9 to 14 as being in improper dependant form. In response, the Applicant respectfully submits that these claims have a proper dependant form if claims 1 to 8 are retained. In light of the above, the Examiner is respectfully requested to reconsider this rejection.

It is believed this response to all of the Examiner's concerns, however if the Examiner has any further questions, he is invited to contact Joy Morrow at (613) 232-2486.

Respectfully submitted,

April 28, 2003
Date

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